

REMARKS

This amendment is submitted in response to the Examiner's Action dated September 18, 2002, and pursuant to a telephonic interview between Examiner and Applicants' representative. In that telephonic interview Applicants argued that the restriction of method claims from program product claims that cover the same method steps was improper. Examiner disagreed and requested Applicants submit the present response clearly outlining the reasons for Applicants' position. Examiner further indicated that he may be persuaded to remove the restriction requirement based on the arguments provided by Applicants.

Applicants have canceled, without prejudice, several un-elected claims in response to the restriction requirements. No further amendments to the claims have been made. Where arguments are provided below to rebut the restriction requirement, those arguments are in reference to the original set of claims including those canceled herein.

ELECTION/RESTRICTIONS

At paragraph 1 of the Action, the Examiner requested a restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-17, drawn to "maintaining confidentiality of personal information", classified in class 705, subclass 26.
- II. Claims 18-28 , drawn to "A computer program product", classified in class 703, subclass 21.

Applicants hereby traverse the above restriction requirement. According to 37 C.F.R. §1.142 and Chapter 803 of the MPEP, restriction is proper if there are two or more independent and distinct inventions claimed in a single application. Specifically, Chapter 803 states that restriction is proper "only if they are **able to support separate patents** and they are independent...or distinct" (emphasis added).

Chapter 802 of the MPEP provides the standard for determining when claims are "independent" and "distinct." As stated therein, "independent" means "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, **operation**, or effect." Further, "distinct" means "that two or more subjects as disclosed are related, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

As divided by Examiner, the Group I claims are drawn to a method (and system) for maintaining confidentiality of personal information during E-commerce transactions. Practicing of these claims necessarily requires program code in a medium readable by a processing component of a data processing system.

Group II claims are drawn to a computer program product, which includes program code for maintaining confidentiality of personal information during E-commerce transactions. The program code of Claims 18-25 of the Group II claims provide similar functionality to that provided by the elements of the method and system claims.

It is clear that the Group II claims are not patentably distinct from the Group I claims and vice-versa. Both groups of claims provide similar functional features (i.e., Group I provides a computer implemented method and Group II provides a disk medium that enables the computer implemented method). If both groups were provided in patent applications filed more than 12 months apart, Examiner would most likely issue a §102 or §103 rejection of the Group I claims over an issued patent containing the Group II claims and vice-versa. Thus, Examiner's restriction requirements fails the second, "distinct" test required for supporting a restriction requirement since the Groups I and II claims are not patentable over each other.

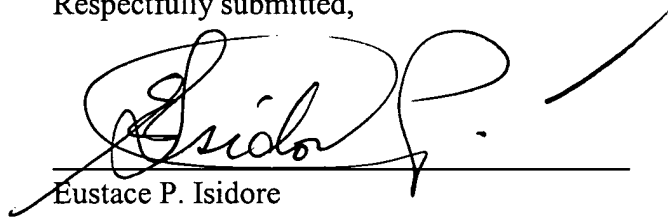
In accordance with the required procedures for responding to a restriction requirement, Applicants hereby elect the Group I claims (Claims 1-17), with traverse. Group II claims are un-elected and have been canceled.

CONCLUSION

Applicants have diligently responded to the Office Action by electing Group I claims, with traverse, and canceling Group II claims from the application. Applicants have provided arguments herein supporting the traversal of the restriction requirement. Applicants therefore respectfully request reconsideration of the restriction requirement of the claims, and if no further rejections or objections be forthcoming, issuance of a Notice of Allowance for all originally pending claims.

Applicants respectfully request the Examiner contact the undersigned attorney of record at (512) 542-2100 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'E. Isidore', is written over a horizontal line. To the right of the signature is a large, sweeping checkmark.

Eustace P. Isidore

Registered with Limited Recognition (see attached)

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REDACTED CLAIMS

1 1. (Unchanged) A method for maintaining confidentiality of personal information during E-
2 commerce transactions comprising the steps of:

3 compiling a profile of personal information within an electronic depository for at least a first
4 party to an E-commerce transaction;

5 providing said first party a unique transaction identifier linked to said profile for use during
6 said E-commerce transaction; and

7 in response to said first party providing said transaction identifier to a second party to said
8 E-commerce transaction, completing said transaction utilizing said electronic depository without said
9 second party receiving any of said personal information.

1 2. (Unchanged) The method of Claim 1, wherein said first party is a buyer and said second party
2 is a merchant having a web server for initiating E-commerce transactions, and said completing step
3 further includes the step of locating said transaction identifier in said electronic depository.

1 3. (Unchanged) The method of Claim 2, wherein said completing step further includes the steps of:

2 assigning a security routing identifier (SRID) for utilization by a shipper and said merchant
3 to match a product with a buyer's address;

4 receiving said transaction identifier along with said security routing identifier at said
5 depository; and

6 forwarding at least a portion of said profile to said shipper along with said SRID, wherein
7 said shipper receives a product from said merchant utilizing only said SRID and sends said product
8 to said buyer utilizing said profile.

1 4. (Unchanged) The method of Claim 3, wherein said receiving step includes the step of
2 automatically notifying said buyer of a receipt of said transaction information.

1 5. (Unchanged) The method of Claim 3, wherein said product for said transaction is electronic and
2 said receiving step further includes the step of electronically receiving said product at said depository
3 and then transmitting said product to said buyer.

1 6. (Unchanged) The method of Claim 1, wherein said step of providing a unique transaction
2 identifier comprises the step of providing a credit card number.

1 7. (Unchanged) The method of Claim 1, wherein said second party and has a unique TID, further
2 comprising the steps of completing said E-commerce transaction on a server of said electronic
3 depository wherein said transaction is completed on said server without said first party and said
4 second party receiving any of said personal information of the other party.

1 8. (Unchanged) A client-based method for maintaining confidentiality of personal information
2 during E-commerce transactions comprising the steps of:

3 creating a profile of personal information within an electronic depository for at least a first
4 party to an E-commerce transaction, wherein said first party is provided a unique transaction
5 identifier linked to said profile for use during said E-commerce transaction; and

6 in response to said first party providing said transaction identifier to a second party to said
7 E-commerce transaction, forwarding information related to said E-commerce transaction to said

8 electronic depository, wherein said transaction is completed by said electronic depository without
9 said second party receiving any of said personal information.

1 9. (Unchanged) The method of Claim 8, further comprising the step of enabling said first party to
2 select whether or not to provide said personal information to said second party.

1 10. (Unchanged) The method of Claim 9, wherein said enabling step further comprises the step of
2 providing a web browser application having a graphical user interface (GUI) on an Internet access
3 system of said client, wherein said GUI provides a plurality of selectable options for said first party
4 including utilizing a transaction identifier to complete said E-commerce transaction.

1 11. (Unchanged) A system for maintaining confidentiality of personal information during E-
2 commerce transactions comprising:

3 an electronic depository utilized for storing a profile of personal information for at least a
4 first party to an E-commerce transaction;

5 registration utility affiliated with said depository for assigning said first party a unique
6 transaction identifier linked to said profile for use during said E-commerce transaction;

7 transaction utility affiliated with said depository for completing said E-commerce
8 transactions utilizing said electronic depository in response to said first party providing said
9 transaction identifier to a second party to said E-commerce transaction, wherein said second party
10 does not receive any of said personal information of said first party.

1 12. (Unchanged) The system of Claim 11, wherein said first party is a buyer and said second party
2 is a merchant having a web server for initiating E-commerce transactions, and said transaction utility
3 includes means for locating said transaction identifier in said electronic depository.

1 13. (Unchanged) The system of Claim 12, wherein said transaction utility further includes:

2 means for assigning a security routing identifier (SRID) for utilization by a shipper and said
3 merchant to match a product with a buyer's address;

4 means for receiving said transaction identifier along with said security routing identifier to
5 said depository; and

6 means for forwarding at least a portion of said profile to said shipper along with said SRID,
7 wherein said shipper receives a product from said merchant utilizing only said SRID and sends said
8 product to said buyer utilizing said profile.

1 14. (Unchanged) The system of Claim 13, wherein said receiving means includes means for
2 automatically notifying said buyer party of a receipt of said transaction information.

1 15. (Unchanged) The system of Claim 13, wherein said product for said transaction is electronic
2 and said receiving means further includes electronically receiving said product at said depository and
3 then transmitting said product to said buyer.

1 16. (Unchanged) The system of Claim 11, wherein said registration utility which provides a unique
2 transaction identifier comprises means for providing a credit card number.

1 17. (Unchanged) The system of Claim 12, wherein said second party also has a unique TID, further
2 comprising means for completing said E-commerce transaction on a server of said electronic
3 depository wherein said transaction is completed on said server without said first party and said
4 second party receiving any of said personal information of the other party.

Please cancel Claims 18-28.

18. Canceled

19. Canceled

20. Canceled

21. Canceled

22. Canceled

23. Canceled

24. Canceled

25. Canceled

26. Canceled

27. Canceled

28. Canceled



**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Eustace P. Isidore is hereby given limited recognition under 37 CFR § 10.9(b) as an employee of Bracewell & Patterson, LLP to prepare and prosecute patent applications and to represent applicants wherein the patent applicants are clients of Bracewell & Patterson, LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of Bracewell & Patterson, LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Eustace P. Isidore ceases to lawfully reside in the United States, (ii) Eustace P. Isidore's employment with Bracewell & Patterson, LLP ceases or is terminated, or (iii) Eustace P. Isidore ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: May 23, 2003

Harry Moatz,
Director of Enrollment and Discipline

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